

Remarks/Arguments:

Applicant appreciates the courtesies extended by Examiner Purol during the telephone interview of August 21, 2008. During the interview the relationship between the instant application and US Patents Nos. 6,719,150 and 7,128,219, and the subject of the double patenting rejections were discussed. The Examiner was made aware that the instant application is directed primarily to the battery assemblies and not just to the rack itself. Applicant also informed the Examiner of its position as to why the double patenting rejections, as well as the art rejection based on Williams et al. reference should be reconsidered and withdrawn. While there were no agreements reached as to patentability, the Examiner did state her intention to take another look at the claims in view of the discussion.

As promised, Applicant suggests one appropriate search area would be in Class 429, looking particularly at sub-classes 99, 100, and 175, and related areas.

Claims 12-18 and 20 are pending. Claim 19 is hereby cancelled and Claims 1-11 have been earlier withdrawn from consideration.

Examiner's Rejections

The Examiner has presented three grounds of rejection:

- A. Claims 12-20 have been rejected on the ground of non-statutory obviousness type double patenting over Claims 1-10 of U.S. Patent No. 6,719,150;
- B. Claims 12-20 have also been rejected on the basis of non-statutory double patenting over Claims 1-5 of U.S. Patent No. 7,128,219, based on the holding in In re Schneller;
- C. Claims 12-20 have also been rejected as being unpatentable over Williams, et al. (U.S. Patent No. 6,167,600).

The above grounds will be addressed in the order presented by the Examiner.

The Instant Invention and Its Relationship to U.S. Patents Nos. 6,719,150 and 7,128,219

The instant application is directed to battery assemblies and to battery systems (batteries, jackets, and rack) that are designed to withstand seismic forces generated during earth tremors and the like. By way of explanation a battery system is a rack and a plurality of battery assemblies (as many as 12, 24, 48 or more). Each battery assembly is a jacket with a cell or jar therein. In each battery assembly, the seam or joint between the battery jar (cell) and its cover is somewhat fragile and can be damaged during assembly into the battery jacket, during handling, or during vibration by engagement with the jacket wall itself. The claimed invention, among other things, is directed to a jacket/jar construction that enables the seam to be protected. The claimed battery system includes the combination of the rack and the battery assemblies.

The instant application is a continuation of the application leading to referenced Patent No. 6,719,150, the claims of which are directed to the rack itself. No claims of the '150 patent recite or are directed to the battery assemblies. Prior to the issuance of the '150 patent and prior to the filing of the continuation application leading to Patent No. 7,128,219, the instant application was filed. As set forth in Applicant's Petition to File on Behalf of Inventor Refusing to Sign, Applicant attempted to get the owner of the '150 patent to join in making the instant application a jointly owned continuation application. However, the owner of the '150 patent (also the owner of the '219 patent) refused. Therefore, the Applicant of the instant application could not have made the claims of the '150 patent or the '219 patent during the pendency of those applications. Note, there is a common inventor in this application as well as the '150 patent and the '219 patent.

There is another reason the Applicant of the instant application could not and should not have made its claims in the '219 patent. The application leading to the '219 patent was filed after the instant application. In fact, the application leading to the '219 patent appears to have been filed thirteen months after the issuance of the '150 patent and is invalid *ab initio* on its face.

A Rejection on the Ground of Non-Statutory Obviousness Type Double Patenting Is Inappropriate

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claims of a patent, the disclosure of the patent may not be used as prior art. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279, 23 USPQ 2d 1839, 1846 (Fed. Cir. 1992). See also MPEP 804 II(D)(1), which states that a non-statutory obviousness type double patenting rejection is appropriate where the conflicting claims are not identical but, at least one application claim is either anticipated by or would have been obvious over the referenced claims.

As earlier explained, the claims of the instant application are directed to the battery assemblies (jacket and battery jar) themselves and to the battery systems that broadly claim a rack, but primarily are directed to the battery assemblies in the rack. On the other hand, the claims of the '150 patent are primarily directed to the rack construction. The battery assemblies themselves are not even recited. Thus, the claims of the '150 patent do not disclose the generally rectangular jacket construction, transversely projecting ears projecting outwardly from the edges of the upper and lower walls that define the open end, the battery jar emplaced in the jacket with a cover sealed to the battery jar forming a seam therebetween, and the jacket being of a length less than the length of the battery jar so that the seam is exposed (all in independent Claims 12 and 15). The remaining claims add even further limitations.

Thus, because of the many differences between the Claims 12 and 15, and the claims of the '150 patent, and because the examiner has failed to articulate reasons why a person skilled in the art would conclude Claims 12 and 15 would have been an obvious variation of the invention described in any of the ten claims of the '150 patent, this rejection cannot be sustained and should be withdrawn.

This Is Not a Proper Case for the Other Type of Non-Statutory Double Patenting Rejection Based on the *In re Schneller* Circumstances

First of all, In re Schneller was a very rare circumstance where the Applicant was very obviously trying to extend the protection he ordinarily would have obtained by several years. Such is not the case in the instant application. As the instant application is a continuation

application, whatever patent might issue here would expire conterminously with the '150 patent. As previously explained, the only reason applicant is not able to file a terminal disclaimer is that, despite Applicant's attempt to make this application and the '150 patent (and the '219 patent) owned by the common assignees, Applicant was unable to do so. Secondly, the owner of the '150 patent and the '219 patent did not present the application leading to these two patents to the Applicants of the present invention and its attorneys, and since Applicant and his attorneys were not party to the applications leading to the '150 patent and the '219 patent, this is a very good reason why Applicant was prevented from presenting claims corresponding to the claims of the instant application. For that matter, a review of the '219 patent file history and its own application will show that the instant claims were actually presented more than one year before the claims leading to the '219 patent.

Thirdly, it cannot be said that Applicant here is attempting to obtain unjustified extension of the right to exclude. Applicant made its own application promptly after becoming aware of the existence of the application leading up to the '150 patent. In fact, the instant application was filed thirteen months before the actual filing date of the continuation application leading up to the '219 patent. Applicant is at a loss to explain how the '219 patent then issued in October of 2006 and the instant application did not get a substantive action until January 2008; however, it was not because of Applicant's delay.

Fourthly, it does not appear from the record that the examiner has obtained the necessary approval of the Technical Center Director to make this rejection. MPEP 804 II(B)(2).

Therefore, for the reasons advanced, this case does not include the unique circumstances that warrant a non-statutory double patenting rejection under the holding of In re Schneller.

Claims 12-20 Are Not Rendered Obvious By Williams Et Al.

A. The Law Requires All Elements to Be Found in the Prior Art and All Modifications to Be Predictable, Not Hindsight. The guidelines for the analysis of the obviousness question begin with 35 U.S.C. § 103, which states that a patent claim is obvious, and thus invalid, when the differences between the claimed subject matter and prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." The obviousness analysis is based on several

underlying issues of facts, namely: (1) the scope and content of the prior art; (2) the level and skill of a person of ordinary skill in the art; (3) differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of nonobviousness. Graham v. John Deere Company, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed. 2d 545 (1966).

When obviousness is based on the teaching of multiple prior art references, the movant (Examiner) must also establish some reason, referred to as a suggestion, teaching, or motivation (TSM) that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. Tech Air, Inc. v. Denso Manufacturing Mfg. Mich. Inc., 192 F.3d 1353, 1359-1360 (Fed. Cir. 1999). While the recent Supreme Court decision of KSR International Co. v. Teleflex Inc. et al., 127 S. Ct. 1727, 550 U.S. ____ (2007) has held that this motivation does not necessarily have to be explicit in the cited prior reference itself, it still must be established by the movant (Examiner).

This reason or suggestion for motivation to combine prior art references may be found either explicitly or implicitly: (1) in the prior art references themselves; (2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (3) from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem. Rulz v. AB Chance Co., 234 F3 654, 655 (Fed. Cir. 2000). Both the Federal Circuit and the Supreme Court consistently warn that the proper analysis of obviousness should avoid hindsight basis. See Graham. The Examiner or movant must identify a reason why a person of ordinary skill in the art would have combined prior art. Absent this identification or reasoning, a Court must infer that the Examiner, Board, or Trial Court used hindsight. In re Kahm, 441 F3 977,986 (Fed. Cir. 2006).

The temptation to engage in hindsight is especially strong with seemingly simple mechanical inventions. This is because combining prior art references without establishing such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability/the essence of hindsight. In re Dembicza, 175 F.3d 998, 999 (Fed. Cir. 1999). Therefore, the CAFC has consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner

claimed. In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the matter claimed. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

In determining whether or not there is a proper basis for combining or modifying references, or whether the Examiner has improperly engaged in hindsight, the Federal Circuit and its predecessor court, the CCPA, has expressed certain guidelines. Paramount among these principles is that All Claim Limitations Must Be Met. After all is said and done, even if the references can be properly combined, all the limitations must be met. In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). Where claimed limitations are absent or ignored, obviousness is not established.

In the recent United States Supreme Court case of KSR International Company v. Teleflex, Inc., et al., 127 S.Ct. 1727 (2007) the Supreme Court reaffirmed the familiar framework for determining obviousness as set forth in Graham v. John Deere Company, 383 U.S. 1 (1966). Further, in KSR, *supra*, it is true the Supreme Court particularly emphasized the need for caution in granting a patent based on a combination of elements which elements could be found in the prior art. However, the Supreme Court cautioned against hindsight bias and ex post reasoning. The KSR decision has resulted in the issuance of a set of guidelines for determining questions of obviousness. See Examination Guidelines for Determining Obviousness under 35 U.S.C. § 103 in view of the Supreme Court decision in KSR, International Co. v. Teleflex, Inc., Federal Register/Volume 72, pages 57526-57535.

B. The Invention Represents a New Approach. As explained in the background and summary portion of the application, the invention set forth in independent Claim 12 of the instant application is a unique configuration that is realized in the relationship between the battery jar (cell), the jacket, its front cover, and how the seam between the front cover and the front face of the cell or jar is protected during installation of the cell into the jacket. According to the present invention, this seam is maintained in front of or exteriorly of the jacket. That way during the installation of the jar in the jacket, or during seismic disturbances the delicate seam will not be damaged. This is a very important feature, and is realized primarily by making the jacket

slightly shorter in length than the jar, which results in the seam at all times being in advance of the front end of the jacket.

Other features of the invention rejected in the dependent claims reside in staggering the ears at the top and bottom wall of the jacket to facilitate assembly as best illustrated in Fig. 6. The shelf configuration of Claim 20 is also a feature that offers advantage to the assembled rack or module to facilitate ventilation in a vertical direction. Further, Claims 15-20 are directed to a battery system that includes a plurality of battery assemblies as described above along with a rack with shelves that support the battery assemblies in one of a plurality of compartments.

C. Williams, et al. Is a Completely Different Construction. The columbarium system of Williams, et al. utilizes a different construction for different purposes. The storage containers are self-framing, and therefore differ substantially. Also, there is no concern about protecting the seam between urn portions 22, 24. More specifically, the Williams, et al. reference fails to disclose:

- a) A generally rectangular jacket having opposed upper and lower walls and opposed side walls and an open end;
- b) Ears projecting outwardly from the edges of the upper and lower walls (nor are these ears staggered as claimed in dependent Claim 13);
- c) The tube 16 (corresponding to the jacket) being of a length less than the length of the urn; and
- d) The seam between the urn 22 and cover 24 being positioned exteriorly of the open end of the tube 16.

All of the above limitations are in Claim 12 and 13, and independent Claim 15 contains even more limitations concerning the rack, such as end frames, shelves divided into zones (Claim 15), and the shelves containing a series of dimples and slots to position the battery assemblies in spaced relation and allow vertical ventilation between the battery assemblies. Williams, et al., of course, discloses none of these rack limitations.

Apparently, the Examiner's analysis is in line with rationale G of the Examination Guidelines, page 57534. However, the Examiner's analysis fails for two reasons.

First, the Guidelines (page 57528) emphasize the holding of the Supreme Court in KSR requires that the analysis supporting a rejection under 35 U.S.C. should be made explicit.

Rejections cannot be substantiated by mere conclusory statements; instead, there must be some articulated reasoning in support. KSR, 82 USPQ 2d at 1396. The Office Action does not provide such an analysis. The only attempt at this analysis is the broad statement at the bottom of page 3 referencing that the person of ordinary skill in the art would have obviously applied the structural teachings of Williams, et al. for the storage of batteries rather than in a columbarium. If the only difference in the claims and in the Williams, et al. reference were that one system is a columbarium and the other stores batteries, that may have been sufficient. However, as pointed out above, there are at least four other differences in Claims 12-14 and even others in Claims 15-20, which are simply not addressed. Applicant submits this is inadequate to support a finding that there was some suggestion or motivation even to one of ordinary skill in the art to modify Williams, et al. to form a rectangular jacket with ears projecting outwardly that are staggered, and to form the cell longer than the jacket to expose the seam in front of the jacket to protect it during handling. It is also noteworthy, when comparing Claims 15-20 with Williams, et al., that Williams, et al. does not even disclose a rack, which is a limitation in each of Claims 15-20.

Secondly, Applicant submits that the Office Action could not have included such an explicit analysis, because it does not exist. The battery assembly of Claims 12-14 (and also recited in Claims 16-20) includes a cell (jar) and jacket. Upon charging, the cell expands and fits very tightly in the jacket. Subsequent handling of the assembly creates much stress on the seam between the cell and the cell cover. By making the jar longer than the cell, this seam never has to enter the walls of the jacket, and therefore damage to this seam is avoided. This feature or any explanation of why the inclusion of it is obvious does not appear in the Office Action. The same is the case with the staggered ears (Claim 13), the retainer bars (Claim 14), and the slits and dimples on the rack shelves that allow vertical ventilation (Claim 20).

Thus, the claims have too many unexplained differences from the Williams, et al. reference for that reference to support a rejection under 35 U.S.C. § 103. The Board of Appeals has repeatedly held that where a limitation is not shown and the Examiner fails to address the limitation or offers no explanation for why a person of ordinary skill in the art would have known to modify to include such limitation, the rejection is improper. Ex Parte Camacho et al. Appeal No. 2007-1933; Ex Parte Iannello et al., Appeal No. 2008-1697.

Conclusion

In view of the response and reasons set forth above, the rejection of Claims 12-18 and 20 should be withdrawn and the case passed to issue. Should any matter remain unresolved, Applicant's counsel would appreciate the courtesy of a telephone call to resolve the matter.

Respectfully submitted,



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